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BRINKS HOFER GILSON & LIONE			WIN, AUNG T	
ONE INDIANA SQUARE, SUITE 1600				
INDIANAPOLIS, IN 46204			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,022	Applicant(s) PORTMAN ET AL.	
	Examiner Aung T. Win	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-73 is/are pending in the application.
- 4a) Of the above claim(s) 37, 49, 60 and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36, 38-48, 50-59, 61-65 and 67-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 36-66 filed on 8/21/2007 have been considered but are moot in view of the new ground(s) of rejection.

Priority

Applicant claims for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c). Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged as follows:

It is noted that the disclosure of continuation-in-part filed applications 10/263523 & 10/264219 fails to provide claim subject matters as disclosed in amended claims or originally filed claims of Application No. 10/751022. Therefore, the benefit of priority filing date is not acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 48 – 58 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim (i.e., computer program and code segment) raises a question as to whether the claim is directed

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merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

It appears that Claims 48 – 58 claim the non-statutory subject matter of a computer program. Data structures not claimed as A computer readable medium for storing a computer program executed by computer are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 71 & 72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner cannot find any support in the disclosure to Claims' limitation "transmitting the voice-based response and the text-based response sequentially" as cited in Claim 71 and "accessing a database to determine a format of the response that is compatible with the wireless terminal" as

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cited Claim 72. Examiner requests the applicant specify the drawing, page, column or line number, which support the claim limitation. Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 59 recites the limitation "**that** information" in last 3 line of Claim 59. There is insufficient antecedent basis for this limitation in the claim. It is unclear what that is referring to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 36, 48, 58, 59, 38, 50, 61, 44, 45, 47, 56, 65, 67-70 & 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1).

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1.1 Regarding Claim 36, Goldfinger discloses a method of providing information assistance to a wireless terminal [wireless communication terminal 12: Figure 2], comprising the steps of:

receiving, from a wireless terminal [wireless terminal 12 of requesting user 18: Column 6], a contact information request with an information assistance application located on an information assistance server [information assistance server 20: Column 6], wherein the contact information request is a request for an information record associated with a subscriber terminal [a request for location information or other information relating to wireless terminal 12 of user 34: Column 6] that is other than the wireless terminal;

generating and transmitting an authorization request to request permission from the subscriber terminal to provide the information record of the subscriber terminal to the wireless terminal [transmitting request for authorization to wireless terminal 12 of user 34: Column 6]; and

receiving a reply from the subscriber terminal indicative of whether or not the requested information record is permitted to be provided to the wireless terminal [user 34 provides authorization information to information assistance server 20: Column 6]; and

generating a response for transmittal to the wireless terminal only when the reply is indicative of permission to proceed with provision of the requested information record

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to the wireless terminal [transmitting to the wireless terminal 12 of user 18 requested information authorized by user 34: Column 6].

Goldfinger does not explicitly teach identifying information step. Tsutsumi discloses the attribute adding program to indicate only information that is identified by a user of wireless communication terminal as permissible to share with other wireless terminal [0038, 0039 & 0047].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Goldfinger's information providing system and method to install attribute adding program as taught by Tsutsumi to identify only information by a user of wireless communication terminal as permissible to share with other wireless terminal to process as claimed. One of ordinary skill in the art at the time of invention of made would have been motivated to provide improved authorizing information method.

Modified system and method as stated above does not explicitly teach a contact preference. Berkley disclose user contact information database comprising user's contact preference [Figure 2] [Ability to reach a user is subject to the user's preference: Column 8, Line 1-16] [Preferred communication option: Column 11, Line 55-Column 12, Line 35].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the method to process the call based on subscriber contact preference as taught by Berkley. One of ordinary skill in the art at the time of invention of made to do this to process the calls efficiently and appropriately

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[Column 4, Line 25-30].

1.2 Claims 48 & 58 are rejected for the same reason as stated above in Claim 1 rejection because claimed executed steps are substantially close to claim 1. At the time of invention of made, it is obvious to one of ordinary skill in the art that modified system would comprises computer readable medium storing claimed computer program executed by processor of wireless computing terminals in order to execute the claimed steps accordingly.

1.3 Claims 59 are the system claim rejected for the same reason as rejections stated above because executed steps by claimed means substantially close to the corresponding steps of Claim 1. It is obvious to one of ordinary skill in the art that modified system and method teaches claimed information assistance application incorporated in the information assistance server in order to process as claimed.

1.4 Claims 38, 50 & 61 are rejected for the same reason as Claim 1 rejection stated above. Regarding Claims 37, 3, 14, 15, 26 & 27, modified system and method teach generating step for providing authorized private information of the subscriber terminal [See Claim 1 rejection].

1.5 Claims 44, 45, 47, 56, 65 are rejected for the same reasons as rejections stated above. Modified system and method teaches determining contact preference based on

the contact preference information database [See Claim 36 rejections].

1.6 Claims 67-70 & 73 are rejected for the same reason as stated above in Claims 36 and 59. It is obvious to one of ordinary skill in the art that the system and method as modified with the teaching of Tsutsumi's identification software program would teach as claimed in Claims 67-70 & 73.

2. Claims 39, 43, 46, 51, 54, 62, 63 & 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1) and Engelke et al. (US007003082B2).

2.1 Regarding Claims 39, 43, 46, 51, 54, 62, 63 & 71, modified system and method does not explicitly teach claimed response method. Engelke teaches providing both text and voice messages to the user [Figure 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify the system and method as taught by Engelke to provide text message and voice message responses as claimed in Claims 39, 43, 46, 51, 54, 62 & 63. One of ordinary skill in the art at the time of invention of made would have been motivated to do this to ensure that the user can be provided with information correctly.

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3. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1) and Futagami et al. (US006754665B1).

3.1 Regarding Claim 40, the system and method as modified above teaches selecting information from a group of information, however does not explicitly disclose all information record items as claimed although user information authorized to be provided is address of the user terminal and other information associated with user and other user personal information [see information disclosed in Goldfinger and Tsutsumi].

Futagami teaches sharing information stored in personal information database [Abstract]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify the system and method as taught by Futagami to register personal information as claimed. One of ordinary skill in the art at the time of invention of made would have been motivated to do this to share registered personal information stored in the network.

4. Claim 41, 52, 55, 57 & 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1) and Elsey (US20020055351A1).

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4.1 The modified method and system does not explicitly disclose voice response unit however such component is expected in information providing system. Elsey disclose voice response unit to process information assistance calls [Elsey: Paragraph 0051 & 0053]. At the time of invention of made, it is obvious to one of ordinary skill in the art that information assistance system teaches determining the identify of the user based on voice recognition module and voice print analysis because modified information assistance method is based on identify of the requesting wireless terminal. Moreover, Interactive Voice Response system (IVR) system for identification users based on voice print analysis and voice recognition application is well known to skilled in the art the at the time of invention of made. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the system with voice response unit as taught by Elsey to modify as claimed. One of ordinary skill in the art at the time of invention of made would have been motivated to do this to provide efficient call processing. It should be noted that concept and advantages of integrating voice response module in communications sytem does not constitute the patentably distinct limitation from modified method and system.

5. Claim 42 & 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1) and Sugiyama et al (US006345245B1).

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5.1 Regarding Claims 42 & 53, modified system and method teaches processing contact information request but does not explicitly disclose processing with Natural Language Processing module. Sugiyama teaches such claimed feature lacks in modified system [Background and Summary] for translating the transmitted information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to utilize natural language processing system as claimed to process contact information request as claimed. One of ordinary skill in the art at the time of invention of made to do this to provide improved information assistance system to process the request effectively [Sugiyama: Background].

6. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfinger et al (US006449344B1) in view of Tsutsumi et al. (US20030078034A1), further in view of Berkely et al. (US006546005B1) and Chaddha et al. (US20050020250A1).

6.1 Regarding Claim 72, modified method and system as stated above does not explicitly teach as claimed in Claim 72. Chaddha teaches transmitting information to the communication terminal that is compatible with the wireless terminal [0047]. It should be noted that such claimed feature is well known to one skill in the art at the time of invention of made. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to further modify the method as claimed as taught by Chaddha. One of ordinary skill in the art at the time of invention of made would have

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been motivated to do this to make improvement in information transmission system according to user's device communications capability.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Group Art Unit 2617
October 25, 2007


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